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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,432	06/07/2001	David T. Berquist	56777USA3A.002	8956
32692	7590	02/27/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			KOYAMA, KUMIKO C	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/876,432	<b>Applicant(s)</b> BERQUIST ET AL.	
	<b>Examiner</b> Kumiko C. Koyama	<b>Art Unit</b> 2876	<i>AW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>091703.092903</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

Acknowledgement is made of receipt of Amendment filed on November 20, 2003.

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 18 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 60 of copending Application No. 09/882,969. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2876

4. Claims 1-24, 48-49 and 67-74 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 60 and 64-77 of copending Application No. 09/882,969 (herein after '969 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of the '969 application.

Re claim 1 of the present invention: Claim 1 of the present invention recites "A method of collecting information related to RFID tags associated with items of interest, comprising the steps of: (a) selecting a category of items using a user interface associated with an RFID reader; (b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest; and (c) associating information related to the at least one item with the selected category."

Re claim 60 of '969 application: Claim 60 of the '969 invention recites "A method of interrogating RFID tags associated with items of interest, comprising the steps of: (a) selecting at least one category of items using a user interface associated with an RFID reader; (b) interrogating RFID tags associated with items, at least one of which is within the category of items; (c) categorizing information related to the at least one item(s) associated with the interrogated RFID tag(s) in at least one of the categories; and (d) ignoring any RFID-tagged-item that may not be categorized in at least one category."

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 32-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-16 and 42 of copending Application No. 09/755,714 (herein after '714 application). Although the conflicting claims are

Art Unit: 2876

not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of the '714 application.

Re claim 32 of the present invention: Claim 32 of the present invention recites "A method of obtaining information related to items associated with RFID tags, comprising the steps of: (a) interrogating the RFID tags in an order; and (b) organizing the information in an order other than the order in which the tags were interrogated."

Re claim 37 of '714 application: Claim 37 of '714 application recites "A method of using an RFID reader for interrogating RFID tags associated with items of interest, by programming the RFID reader to provide specified information regarding each item of interest in a specified order on a user interface associated with the RFID reader, at least some of the information being selected from the group consisting of a name or title of the item, s serial or call number of the item, and a desired location for the item."

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 25-49 are rejected under 35 U.S.C. 102(a) as being anticipated by Garber et al (US 6,232,870).

Garber teaches a method of using a portable RFID device with a group of items each having an RFID tag, inputting information to the device describing a certain item or class of items, scanning the RFID tags associated with each item in the group of items, receiving signals from each of the scanned RFID tags, and comparing the received signals to the information input to the device to determine whether the certain item or class of items are present amount the group of items (col 18, lines 55+).

Re claim 25 and 38: Garber teaches using the information input to update a database that includes information to an item (col 20, lines 11-12), scanning the RFID element associated with the item and determining whether the certain item belongs with the group of items (col 19, lines 45-51).

Re claim 32 and 48: Garber teaches inputting an algorithm to the device that describes an ordered set of items, scanning a plurality of items having RFID elements to obtain information from those elements, which serves as interrogating the RFID tags in an order, and comparing a description of the items obtained using the information obtained from the RFID elements to the algorithm to determine whether the scanned items or in the algorithm order, which serves as organizing the information in an order other than the order in which the tags were interrogated (col 19, lines 19-27). Garber also teaches providing an indication to a user of any item that is not in the algorithm order (col 19, lines 27-30).

Re claim 39: Garber teaches scanning a plurality of items having RFID elements to obtain information from those elements, and comparing a description of the items obtained using the information obtained from the RFID elements to the algorithm to determine whether the scanned items are in the algorithm order (col 19, lines 20-27). Garber also teaches that

Art Unit: 2876

comparing information is compared with information describing missing items, which determines the presence or absence of the items in a storage area (col 19, lines 1-5).

Re claim 40 and 41: Garber teaches interrogating RFID tags, each associated with an item to determine information related to the items for a first purpose of searching for certain items on a predetermine search list and using the information for a second purpose of determining the presence or absence of the items in the storage area (col 18, lines 55+ and col 19, line 1-5).

Re claim 42 and 45: Garber teaches using an RFID device for scanning the RFID tags associated with each item and comparing the received signals to the information input to the device to determine whether the certain item or class of items are present among the group of items, which serves as a inventory list (col 18, lines 55+ and col 19, lines 42+). Garber also teaches providing an indication of the determination made whether the certain item belongs with the group of items to the user in real time (col 19, lines 50+).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garber in view of Markman (US 5,794,213).

Garber teaches a method of using a portable RFID device with a group of items each having an RFID tag, inputting information to the device describing a certain item or class of items, scanning the RFID tags associated with each item in the group of items, receiving signals from each of the scanned RFID tags, and comparing the received signals to the information input to the device to determine whether the certain item or class of items are present amount the group of items (col 18, lines 55+).

Garber fails to teach categorizing information related to the at least one item(s) associated with the interrogated RFID tag(s) obtained in step (b) in at least one of the categories selected in step (a).

Markman teaches a method and apparatus for reforming grouped items. The invention includes garments that are associated in a group and are separated from other members of the group and mixed with other articles and groups during processing then are regrouped in their original units (col 5, lines 24-30). The group identification of each article is read by scanning a barcoded group code and article count and the location of the group is located, which is considered as categorizing (col 5, lines 33-45).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Markman to the teachings of Garber in order to relocate where the item belongs so that the item can be placed at its designated spot, which not only places the item in it designated category, but also confirms that the item is not misplaced or missing.

10. Claims 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garber in view of Markman (US 5,794,213) and Harrison et al (US 6,176,425).



Garber teaches a method of using a portable RFID device with a group of items each having an RFID tag, inputting information to the device describing a certain item or class of items, scanning the RFID tags associated with each item in the group of items, receiving signals from each of the scanned RFID tags, and comparing the received signals to the information input to the device to determine whether the certain item or class of items are present amount the group of items (col 18, lines 55+).

Garber fails to teach categorizing information related to the at least one item(s) associated with the interrogated RFID tag(s) obtained in step (b) in at least one of the categories selected in step (a).

Markman teaches a method and apparatus for reforming grouped items. The invention includes garments that are associated in a group and are separated from other members of the group and mixed with other articles and groups during processing then are regrouped in their original units (col 5, lines 24-30). The group identification of each article is read by scanning a barcoded group code and article count and the location of the group is located, which is considered as categorizing (col 5, lines 33-45).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Markman to the teachings of Garber in order to relocate where the item belongs so that the item can be placed at its designated spot, which not only places the item in it designated category, but also confirms that the item is not misplaced or missing.

Garber as modified by Markman fail to teach ignoring any RFID-tagged item that may not be categorized in at least one category.

Art Unit: 2876

Harrison teaches that if a tag identification number is detected which is not associated with any semantics, the program can ignore the tag (col 13, lines 40-48).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Harrison to the teachings of Garber as modified by Markman so that other unrelated tags are not associated with the certain category, and avoid any confusion to the user as well as to the program used in the interrogating equipment to properly perform the function.

### ***Response to Arguments***

11. Applicant's arguments filed November 20, 2003 have been fully considered but they are not persuasive.

In response to arguments with respect to claims 1-17, the Applicant has amended the claims such that it necessitated the examiner to conduct a new search and consideration.

Therefore, the arguments have been moot in view of new grounds of rejection.

In response to arguments with respect to claims 18-24, the examiner has reconsidered the claims and provided a new ground of rejection. Therefore, the arguments with respect to these claims are moot in view of new grounds of rejection, and the instant Office Action is Non-Final Office Action.

In response to arguments with respect to claims 25-31, the examiner respectfully disagrees. The Applicant has submitted that "the support for anticipation rejection in the Office Action is portions of issued claims 11 and 14 of Garber, which is not sufficient under the current law... Claim 25 of the present application did not match the issued claims 11 and 14 of Garber."

Art Unit: 2876

Although Garber is not word-by-word identical to claim 25 of the instant application, the examiner believes that Garber teaches the invention of claim 25 and disclose each element. For example, claim 25 discloses “providing a database including entries associated with certain items” and Garber discloses “a database that includes information as to that item.” Similarly, step (b) discloses “interrogating RFID tags associated with item” and Garber discloses “using portable RFID device to interrogate the RFID element and obtain information therefrom.” And finally, step (c) discloses “providing an indication to a user when an RFID tag associated with an item that is not on the database is interrogated” and Garber discloses “providing an indication of the determination made in step (c) to the user in real time,” in which this case step (c) is the determination of whether the certain item belongs with the group of items, which is a database. The Applicant also further describes the specifics of the claimed invention in the arguments and referencing to the specification for such disclosure. However, the specific details are not described in the claims or claim 25. Therefore, under the practice of broadest interpretation, the examiner believes that the Garber reference still reads on the claims and maintains her rejection.

Regarding claims 32-36, the Applicant submitted in the arguments that claims 32-36 have been canceled. However, on Page 14 of the response, the Applicant writes “claims 1 to 49 are pending.” The examiner respectfully requests the Applicant to submit a confirmation as to whether claims 32-36 have been canceled or are still pending.

In response to arguments with respect to claim 38, the examiner respectfully disagrees. Garber teaches scanning the RFID for the purpose of determining whether the certain item belongs with the group of items as described above. To provide a further detail information about Garber, Garber also discloses that a scanned RFID tags can be used to compare the signals

Art Unit: 2876

received from the reader to determine whether it matches with the information provided, such as describing missing items, items that have not been used within a specified period of time, items that have not been checked into inventory, items that have been designated for hold status, and the owner of the items. Such disclosure teaches that the interrogation of the RFID tags is used for multiple purposes and one of the purposes include comparing for a match under missing items, which determines the presence or absence of the items in the storage area. Therefore, under the practice of broadest interpretation, the examiner believes that the Garber reference still reads on the claims and maintains her rejection.

In response to arguments with respect to claim 39, the examiner has reconsidered this claim and has provided new ground of rejection. Therefore, the arguments are moot in view of new grounds of rejection and the instant Office Action is a Non-Final Office Action.

In response to arguments with respect to claim 40, 41 and 38, the examiner respectfully disagrees. The examiner refers back to the examiner's response provided for arguments regarding claim 38 for the determination of presence and absence issue. The Applicant does not describe in detail what involves in the actual determining of the presence and absence of the item, the multiple operations, and/or the ordering of items that the Applicant is trying to claim as described in the arguments and as described in specification section of the instant application. Therefore, under the practice of broadest interpretation, the examiner believes that the Garber reference still reads on the claims and maintains her rejection.

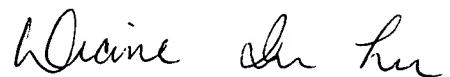
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 571-272-2394. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kumiko C. Koyama  
February 09, 2004



**DIANE I. LEE  
PRIMARY EXAMINER**